



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Bezos, et al.)	Group Art Unit: 3625
)	
Appl. No.	:	09/377,322)	
)	
Filed	:	August 19, 1999)	
)	
For	:	PURCHASE NOTIFICATION)	
		SERVICE FOR ASSISTING)	
		USERS IN SELECTING ITEMS)	
		FROM AN ELECTRONIC)	
		CATALOG)	
)	
Examiner	:	Naeem Haq)	
)	

REQUEST FOR REINSTATEMENT OF APPEAL

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

In response to the non-final Office Action mailed on July 16, 2004, Appellants hereby request reinstatement of the appeal pursuant to 37 C.F.R. 1.193(b)(2)(ii). A Supplemental Appeal Brief is enclosed. Please charge any fees that may be due, including any extension fees, to deposit account 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9-10-04

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SUPPLEMENTAL APPEAL BRIEF

Board of Patent Appeals and Interferences
Washington, D.C. 20231

Dear Sir:

This Supplemental Appeal brief is being submitted in accordance with 37 C.F.R. 1.193(b)(2)(ii), together with a Request for Reinstatement of Appeal, to address the new grounds for rejection set forth in the Office Action mailed on July 16, 2004. The new rejections are based on the same references relied on by the Examiner in the prior Office Action (namely Bieganski, Chislenko, and Information Week, collectively referred to herein as "the applied references"), although the Examiner has now relied on a subset of these references (namely Bieganski in combination with Information Week) to reject most of the claims at issue.

Appellants hereby incorporate by reference the following sections from their original Appeal Brief:

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of the Claims
- IV. Status of Amendments

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- V. Summary of the Invention
- VII. Grouping of Claims
- VIII-A. Explanation of separate patentability of claim groups
- VIII-B. Discussion of References Relied Upon by Examiner
- Appendix (Claim Listing)

A. SUMMARY OF OFFICE ACTION

In the Office Action mailed on July 16, 2004 (hereinafter "the Office Action"), the Examiner rejected Claims 45, 48, 50, 53 and 63 on obviousness grounds over Bieganski (U.S. Patent No. 6,321,221) in view of Information Week "Just Add People" (hereinafter "Information Week").

In addition, the Examiner rejected Claims 46, 49, 54 and 55 on obviousness grounds over Bieganski in view of Information Week, and further in view of Chislenko (U.S. Patent No. 6,041,311); and rejected Claim 47 on obviousness grounds over Bieganski in view of Information Week, Chislenko, and Official Notice.

B. ISSUES PRESENTED ON APPEAL

In view of Appellants' claim groupings, as set forth in their original Appeal Brief, the following issues are presented on appeal:

With respect to Groups 1-3 and 5, whether Claims 45, 48, 50, 53 and 63 are properly rejected on obviousness grounds over Bieganski in view of Information Week; and

With respect to Group 4, whether Claims 46 and 55 are properly rejected on obviousness grounds over Bieganski in view of Information Week and Chislenko.

The other rejected claims stand or fall based on the Board's decisions with respect to Claims 45, 46, 48, 50, 53, 55 and 63.

C. DISCUSSION OF ISSUES ON APPEAL

The obviousness rejections are improper because (1) the applied references do not disclose or suggest all of the limitations of the broadest claim or claims in any claim group, and

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(2) the applied references do not disclose or suggest the desirability of the claimed invention. Each of these two separate bases for reversing the obviousness rejections is discussed below.

1. The applied references do not disclose or suggest all of the claim limitations of the broadest claim(s) of each claim group.

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. In this case, the applied references fail to satisfy this requirement with respect to the broadest claim or claims of each claim group. Each claim group is discussed separately below.

Group 1

Group 1 consists of independent Claim 45, and Claim 49 which depends from and stands or falls with Claim 45. Claim 45 reads as follows:

45. A computer implemented method of assisting users in selecting items to purchase from an electronic catalog of items, the method comprising:

 maintaining purchase history data for each of a plurality of users of the electronic catalog;

 maintaining community data indicative of user memberships within specific explicit-membership communities that users explicitly join, wherein each of the explicit-membership communities represents a respective subset of a general user population;

 monitoring online browsing of the electronic catalog by a first user who is a member of an explicit-membership community to detect that an item accessed by the first user has been purchased by a second user who is also a member of the explicit-membership community, as reflected by the purchase history data and the community data; and

 in response to detecting that the item has been purchased by the second user, supplementing a catalog page requested by the first user to include a notification that the item has been purchased by the second user, said catalog page being a page on which the item is displayed.

The Examiner rejected Claim 45 as obvious over Bieganski in view of Information Week. Appellants submit that the rejection of Claim 45 is improper because, *inter alia*, neither Bieganski nor Information Week discloses or suggests “maintaining community data indicative of user memberships within specific explicit-membership communities that users explicitly join.”

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The Examiner takes the position that Information Week discloses the use of “explicit-membership communities that users explicitly join,” as set forth in the claim. See Office Action at bottom of page 3, and at page 11, lines 16-20, where the Examiner asserts that “Information Week clearly states that users explicitly join a specific group.” Appellants respectfully disagree. The feature described in the cited portion of Information Week involves the ability for a user to submit a specific group of people and obtain recommendations that are based on their collective preferences. Nothing in Information Week suggests that the users “explicitly join” this group as set forth in the claim. Rather, the group is apparently specified solely by the user seeking recommendations, without the involvement or knowledge of the selected users.

Further, the submission of a group of people, as described in Information Week, does not appear to result in the formation of a “community” for which “community data indicative of user memberships” is maintained. Rather, the submitted group is apparently used to generate a personalized set of recommendations, and nothing more.

The applied references also fail to disclose or suggest “supplementing a catalog page requested by the first user to include a notification that the item has been purchased by the second user, said catalog page being a page on which the item is displayed,” in the context of the other claim limitations. In connection with this portion of the claim, the Examiner relies on Information Week’s disclosure, at page 2, paragraph 5, of a software application that generates a personalized home page with information about similar users. This personalized home page, however, is not “a catalog page … on which the item [purchased by the second user] is displayed.” In addition, nothing in Information Week suggests supplementing the page with a notification that an item displayed thereon has been purchased by the second user.

To the extent the Examiner may be asserting that it would be obvious to modify the home pages of Information Week to provide the claimed notifications, Appellants respectfully disagree. One skilled in the art would not have been motivated to make such a modification because, among other reasons, Bieganski and Information Week do not address the significant privacy issues that would be raised if users were to be notified of purchases made by other users. (Note that Appellants’ disclosed embodiments address these privacy issues in-part through the use of explicit-membership communities that users explicitly join, and by providing options, such as those depicted by reference numbers 36, 40 in Figure 1, for users to control whether and to what

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extent their purchases are exposed to others.) Thus, Bieganski and Information Week cannot be construed as suggesting that the personal home pages of Information Week be modified to provide the claimed notifications on catalog pages.

Because the applied references fail to disclose or suggest all of the limitations of Claim 45, the obviousness rejection of the Group 1 claims is improper.

As discussed separately below, Appellants also believe the rejections of the claims of Groups 1-5 are improper because the applied references do not suggest the desirability of the claimed invention.

Group 2

Group 2 consists of Independent Claim 53, and Claim 54 which depends from and stands or falls with Claim 53. Claim 53 reads as follows:

53. A computer implemented method of assisting users in selecting items to purchase from an electronic catalog of items, the method comprising:

maintaining purchase history data for each of a plurality of users of the electronic catalog;

maintaining personal address book data for each of a plurality of the users; monitoring online browsing of the electronic catalog by a first user to detect that an item accessed by the first user has been purchased by a second user that is included in a personal address book of the first user, as reflected by the purchase history data and the personal address book data; and

in response to detecting that the item has been purchased by the second user, supplementing a catalog page requested by the first user to include a notification that the item has been purchased by the second user;

wherein the method is performed by a server system that provides functionality for browsing and making purchases from the electronic catalog.

The Examiner rejected Claim 53 as obvious over Bieganski in view of Information Week. Appellants submit that the rejection of Claim 53 is improper because, *inter alia*, Bieganski and Information Week do not disclose or suggest all of the limitations of this claim.

For example, Bieganski and Information Week do not disclose or suggest "maintaining personal address book data for each of a plurality of the users." In this regard, the description of GroupLens 2.5 in Information Week does not imply the use of personal address books, as the disclosed function of submitting a group of people can be performed without using personal

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address books. For instance, the user seeking recommendations could specify the group of people by typing in their email addresses, or by selecting from a master list of all users of the particular installation of the GroupLens 2.5 system.

Bieganski and Information Week also fail to disclose or suggest “monitoring online browsing of the electronic catalog by a first user to detect that an item accessed by the first user has been purchased by a second user that is included in a personal address book of the first user, as reflected by the purchase history data and the personal address book data.” As mentioned above, Information Week does not suggest the use of personal address books. In addition, even if Information Week could be read as suggesting the use of a personal address book to define a group of users to submit (as asserted by the Examiner), it still would not be obvious from Bieganski and Information Week to use such personal address books as claimed—namely “to detect that an item accessed by the first user has been purchased by a second user that is included in a personal address book of the first user.”

Bieganski and Information Week also fail to suggest “in response to detecting that the item has been purchased by the second user, supplementing a catalog page requested by the first user to include a notification that the item has been purchased by the second user.” The personalized home page disclosed in Information Week is not a “catalog page.” In addition, neither Bieganski nor Information Week suggests notifying one user that an item has been purchased by another user—by supplementing a catalog page or otherwise.

Appellants assume that the reference to the Chislenko patent in the last line of page 6 of the Office Action is a remnant of the prior Office Action, and that the Examiner is not currently relying on Chislenko in rejecting Claim 53.

Because Bieganski and Information Week fail to disclose or suggest all of the limitations of Claim 53, the obviousness rejection of the claims of Group 2 is improper.

Group 3

Group 3 consists of dependent Claim 50, which depends from Claim 45 (Group 1). The Examiner rejected Claim 50 based on Bieganski in view of Information Week.

Claim 50 adds the limitation “wherein the community is a private community.” As disclosed at page 10, lines 23-29 of the present application, the use of private communities provides

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a mechanism for a closed group of users to privately share information about their purchases with each other:

In the illustrated embodiment, a user wishing to add a new community has the option of designating the community as “private,” meaning that the community’s existence and/or data will not be exposed to the general public. Private communities may be useful, for example, when a closed group of users wishes to privately share information about its purchases.

When read in conjunction with independent Claim 45, Claim 50 requires a community that is both private and is explicitly joined by its members. The Examiner takes the position that Information Week discloses or suggests such a community through its disclosure of the GroupLens 2.5 feature that allows a user to submit a group of people to obtain recommendations. See Office Action from page 3, line 15 to the bottom of page 4. Appellants disagree. As discussed above, the submission of a group of people, as described in Information Week, does not result in the formation of a community, let alone a private community that users explicitly join. The rejection of Claim 50 is therefore improper.

Group 4

Group 4 consists of dependent Claims 46, 47 and 55. The Examiner rejected these claims on obviousness grounds over Bieganski in view of Information Week, in further view of Chislenko. See Office Action at page 8, line 9 to page 9, line 2.

The Group 4 claims require the following additional feature: “in response to detecting that the item has been purchased by the second user, providing an option to the first user to send a message to the second user.” As disclosed in the present application, this feature provides a mechanism for a first user who is interested in a particular item to obtain information about the item from a second user who has already purchased the item. This feature provides a patentable distinction over the applied references when viewed in the context of the limitations of base Claims 45 and 53.

The Examiner takes the position that this feature is obvious in view of the messaging function disclosed at col. 21, lines 11-26 of Chislenko, which facilitates communications between users that share a common interest. See Office Action at page 8, last paragraph.

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Appellants respectfully disagree, as neither this nor any other portion of Chislenko, or the other applied references, suggests the combination of (1) supplementing the requested catalog page with a notification that the item has been purchased by the second user (as recited in the base claims), and (2) providing an option to send a message to the second user.

Because the claims in Group 4 require additional limitations that are not suggested by the applied references, the Group 4 claims are patentable over the applied references regardless of the disposition of base Claims 45 and 53.

Group 5

Group 5 consists of dependent Claims 48 and 63, which depend from independent Claims 45 and 53, respectively. The Examiner rejected Claims 48 and 63 over Bieganski in view of Information Week.

Claims 48 and 63 each add the limitation “wherein the catalog page is an item detail page.” When read in conjunction with the respective base claims, Claims 48 and 63 require that an item detail page requested by the first user be supplemented to include a notification that the item has been purchased by the second user. As is well known in the art, an item detail page, in the context of an electronic catalog, is an electronic catalog page that features a particular catalog item, such as a particular product, and which typically provides functionality for users to select the item for purposes of placing an order. One example of such a page is shown in Figure 3 of the present application.

In his analysis of this claim at page 7 of the Office Action, the Examiner takes the position that it would be obvious to incorporate item detail pages into a system that combines the teachings of Bieganski and Information Week. However, the Examiner does not reach the issue of whether it would have been obvious to supplement an item detail page with a notification regarding a purchase of an associated item by a second user. Indeed, neither Bieganski nor Information Week suggests supplementing an item detail page with this, or any other, type of notification.

The Examiner additionally takes the position that the term “item detail page” represents nonfunctional descriptive material, and is therefore non-limiting. Office Action at page 7, line 8 to page 8, line 8. Appellants disagree. The limitations added by Claim 48 and 63 further define the methods of Claims 45 and 53, respectively, by further specifying both (1) the type of

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electronic catalog page that is “requested by the first user,” and (2) the type of electronic catalog page that is supplemented to include a notification that the item has been purchased by a second user. The added limitations are thus functionally involved in the steps of the recited methods.

The “nonfunctional descriptive material” cases cited by the Examiner, namely *In re Gulack*, 703 F.2d 1381, 217 USPQ 410 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), do not suggest otherwise. Both cases involve device claims, and do not appear to be relevant to the method claims at issue. In addition, in both cases, the Federal Circuit decided that the claim language at issue *should* be treated as limiting. For these reasons, the Examiner’s reliance on *In re Gulack* and *In re Lowry* is misplaced. The MPEP section cited by the Examiner, namely section 2106, similarly fails to support the Examiner’s position.

Because the limitations added by Claims 48 and 63 further define the methods of Claims 45 and 53, respectively, and are not disclosed or suggested by Bieganski and Information Week, Claims 48 and 63 are patentable regardless of the disposition of Claims 45 and 53.

2. The applied references do not suggest the desirability of the claimed invention.

As set forth in MPEP 2143.01, in order to establish obviousness based on a combination of references, the prior art must suggest the desirability of the claimed combination. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (emphasis original), citing *In re Mills*, 916 F.2d 680; 16 USPQ2d 1430 (Fed. Cir. 1990).

Appellants respectfully submit that the applied references do not suggest the desirability of the claimed invention. For example, none of the applied references suggests the desirability of notifying a first user that a catalog item that he or she is accessing has been purchased by a second user who either (1) is a member of an explicit-membership community of which the first user is a member (Claim 45), or (2) is included in a personal address book of the first user (Claim 53). As described in Appellants’ original Appeal Brief, the desirability of providing such notifications is that the notifications allow users to efficiently make more informed purchase decisions that reflect the knowledge, research, and purchase decisions of other users.

Because the applied references fail to suggest the desirability of the claimed invention, the rejections of the claims of Groups 1-5 are improper.

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D. CONCLUSION

For the reasons set forth above, Appellants submit that the rejections of the claims of Groups 1-5 are improper, and request that these rejections be reversed.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9-10-04

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